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EXAMINER

SMITH, PETER J

ART UNIT PAPER NUMBER

2176

DATE MAILED: 03/10/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/552,262

Applicant(s)

DUNIETZ ET AL.

Examiner

Peter J Smith

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 April 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 9.11.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

1. This action is responsive to communications: application filed on 04/19/2000, IDS filed on 12/05/2001 and 06/25/2003.
2. The rejection of claims 16-19 and 21 under 35 U.S.C. 102(e) as being anticipated by Murashita, US 6,330,574 filed 03/30/1998 has been withdrawn as necessitated by amendment.
3. The rejection of claims 24-31 under 35 U.S.C. 102(a) as being anticipated by "Open eBook Publication Structure 1.0" published 09/16/1999 has been withdrawn in light of Applicant's argument.
4. Claims 1-35 are pending in the case. Claims 1, 10, 12, 14, 16, 19, 24, and 32 are independent claims.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 1-7, 9, 12-13, 16-23, and 32-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murashita, US 6,330,574 filed 03/30/1998 in view of "Open eBook Publication Structure 1.0" (hereafter referred to as Open eBook) published 09/16/1999.**

Regarding independent claim 1 and dependent claim 9, Murashita teaches separating a tag from content with a separation variable and replacing a tag with an alias, wherein the alias is a pre-defined representation for the tag in col. 3 lines 12-33. What Murashita does not teach is

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inserting at least one flag within a tag to form an encode tag structure. Open eBook teaches inserting metadata information which could be at least one flag within a tag to form an encode tag structure in section 2.2 lines 7-12.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined Open eBook into Murashita to create the claimed invention. It would have been obvious and desirable to include the metadata insertion of Open eBook with the tag replacement so that the information contained in the tags allows the program to process the document more effectively and in more detail.

Regarding dependent claim 2, Murashita teaches replacing at least one attribute type within the tag with an attribute alias, wherein the attributes alias is a predefined representation for the attribute type in col. 3 lines 12-33.

Regarding dependent claim 3, Murashita does not teach UTF-8 encoding the first encoded document to form a second encoded document. Open eBook does teach UTF-8 encoding the first encoded document to form a second encoded document in section 1.4.6. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined Open eBook into Murashita to create the claimed invention. It would have been obvious and desirable to use UTF-8 encoding taught by Open eBook to create a second document so that it only uses half of the space a UTF-16 document would require. This would have been desirable and beneficial for using less storage space and taking less time to transmit the file.

Regarding dependent claim 4, Murashita teaches compressing the second encoded document to form a compressed document in col. 3 lines 12-24.

Regarding dependent claim 5, Murashita does not teach inserting a position flag to indicate whether the tag is a start tag or an end tag. Open eBook teaches inserting metadata which could be a position flag and also teaches start and end tags in sections 2.2 and 3.1.5. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined Open eBook into Murashita to create the claimed invention. It would have been obvious and desirable to include a position flag in the metadata to indicate the start or end of the content so that the program can more easily process the content.

Regarding dependent claim 6, Murashita does not teach inserting a word break flag between a left and right term of associated content. Open eBook does teach inserting additional metadata to describe the content which could include inserting a word break flag between a left and right term of associated content in section 2.2 lines 7-12. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined Open eBook into Murashita to create the invention as claimed. It would have been obvious and desirable include word break metadata in the tag so that the word breaks could have been easily located by the program.

Regarding dependent claim 7, Murashita does not teach inserting a no search flag in association with a portion of content information. Open eBook does teach inserting additional metadata which could be inserting a no search flag in association with a portion of content information in section 2.2. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined Open eBook into Murashita to create the claimed invention. It would have been obvious and desirable to include a no search flag metadata to enhance the performance of the program processing the document.

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Regarding independent claim 12 and dependent claim 13, Murashita teaches identifying a tag within a document associated with a portion of content in the abstract. Murashita does not teach determining whether the portion is to be displayed for viewing by a reading device or if the portion is not to be displayed for viewing, inserting a no search flag in association with the portion. Open eBook does teach determining whether the portion is to be displayed for viewing by a reading device in section 3.3 and if the portion is not to be displayed for viewing, inserting a no search flag in association with the portion in section 2.2 lines 7-12.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined Open eBook into Murashita to create the claimed invention. It would have been obvious and desirable to have combined the display determination and metadata insertion of Open eBook into Murashita so that the parts of the document not displayed do not consume processing time of the program for certain functions.

Regarding independent claim 16 and dependent claim 18, Murashita teaches locating a tag within an electronic document associated with a portion of content in col. 3 lines 17-19 and Fig. 3. Murashita teaches identifying a pre-defined integer alias for the tag in col. 3 lines 19-22 and in Fig. 3. Murashita also teaches replacing the tag with the alias in col. 3 lines 22-24 and in Fig. 3. Murashita does not specifically teach inserting at least one code character into the electronic document to separate markup language from content, but Murashita does teach separating the markup language from content in fig. 32 and 33 and inserting code characters into the electronic document in the abstract and col. 3 lines 7-42. Murashita also teaches discriminating between tags and document content in col. 3 line 51 – col. 4 line 6.

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It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used Murashita to have created the claimed invention. It would have been obvious and desirable to have inserted code characters before and after the tags so that the discriminating unit could have determined which portions of the document were content items and which parts of the document were markup language tags.

Regarding dependent claim 17, Murashita teaches locating an attribute type with a tag in col. 3 lines 17-19. Murashita discloses identifying a pre-defined attribute alias for the attribute type in col. 3 lines 19-22. Murashita also discloses replacing the attribute type with the attribute alias in col. 3 lines 22-24.

Regarding independent claim 19, Murashita teaches at least one tag having encoded therein a predefined integer alias for a tag in col. 3 lines 17-22. Murashita discloses a content portion associated with a tag in col. 3 lines 12-17. Murashita also discloses a code separating a tag from a content portion in col. 3 lines 22-24.

Regarding dependent claim 20, Murashita does not teach group of flags consisting of WORDBREAK, NOSEARCH, STARTTAG, and ENDTAG. Open eBook does teach adding additional metadata to the tags which could include a group of flags consisting of WORDBREAK, NOSEARCH, STARTTAG, and ENDTAG in section 2.2 lines 7-12. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined Open eBook into Murashita to create the claimed invention. It would have been obvious and desirable to have used the metadata additions taught by Open eBook to have increased the ability of the program to manipulate the document.

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Regarding dependent claim 21, Murashita teaches at least one pre-defined attribute type alias in col. 3 lines 12-24.

Regarding dependent claim 22, Murashita does not teach UTF-8 encoding the markup language document. Open eBook does teach UTF-8 encoding markup language document in section 1.4.6. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined Open eBook into Murashita to create the claimed invention. It would have been obvious and desirable to use UTF-8 encoding taught by Open eBook to create a second document so that it only uses half of the space a UTF-16 document would require. This would have been desirable and beneficial for using less storage space and taking less time to transmit the file.

Regarding dependent claim 23, Murashita teaches a compressed markup language document in the abstract.

Regarding independent claim 32 and dependent claim 35, Murashita teaches receiving a document having a first format in col. 3 lines 12-33. Murashita also teaches processing a document to encode and pre-compute a markup language with the document in the abstract and col. 3 lines 12-33. Murashita teaches forming a converted document in the abstract and fig. 6. Murashita does not teach a document comprising a root directory and a content subdirectory having nested therein at least one linked content file providing content information relating to the converted document linked to the root directory. Open eBook does teach a document comprising a root directory and a content subdirectory having nested therein at least one linked content file providing content information relating to the converted document linked to the root directory in sections 2.2 and 2.3.

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It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined Open eBook into Murashita to create the claimed invention. It would have been obvious and desirable to use the document format taught by Open eBook to improve Murashita so that the content could be better conveyed to a reader.

Regarding dependent claims 33 and 34, Murashita does not teach the Open eBook format or an electronic book document. Open eBook does teach both the Open eBook format and an electronic book document in section 1.1. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined Open eBook into Murashita to create the claimed invention. It would have been obvious and desirable to have used the Open eBook format as well as an electronic book format to enhance Murashita so that the information is better conveyed to a reader.

7. Claims 24-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over “Open eBook Publication Structure 1.0” (hereafter referred to as Open eBook) published 09/16/1999 in view Murashita, US 6,330,574 filed 03/30/1998.

Regarding independent claim 24, Open eBook teaches a root directory and a content subdirectory having nested therein on linked content file providing content information relating to the electronic book linked to the root directory in sections 2.2 and 2.3. Open eBook does not teaches wherein the content file is pre-computed and encoded to minimize computational run-time requirements. Murashita does teach pre-computing and encoding a content file to minimize computational run-time requirements in the abstract and fig. 6. Murashita reduces the size of the

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document file and thus reduces the computational run-time requirements needed to utilize the document.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined Murashita into Open eBook to have created the claimed invention. Open eBook was developed for providing documents as electronic books, including use in portable electronic books, which are generally understood to have less memory and computing power than traditional desktop computers. It would have been obvious and desirable to have used Murashita to compress the size of an Open eBook document so that either the computing ability of a portable electronic book could have been reduced to save cost and reduce physical size, or to increase the size of documents that current portable electronic books could have stored and rendered.

Regarding dependent claim 25, Open eBook teaches at least one link destination index file linked to the content file in section 2.3.

Regarding dependent claim 26, Open eBook teaches a page break index providing an index of page break corresponding to the electronic book in sections 2.3, 2.5 and 2.6.

Regarding dependent claim 27, Open eBook teaches a metadata file linked to the root directory and having information about the electronic book in sections 2.3.

Regarding dependent claim 28, Open eBook teaches a manifest file linked to the root directory providing a listing of the files in the content subdirectory relating to the electronic book.

Regarding dependent claim 29, Open eBook teaches using at least one Cascading Style Sheet (CSS) file in section 4.

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Regarding dependent claim 30, Open eBook teaches a metadata file linked to the root directory and having information about the electronic book in sections 2.2 and 2.3.

Regarding dependent claim 31, Open eBook teaches a digital rights management database linked to the root database in sections 2 and 2.1.

8. Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over “Open eBook Publication Structure 1.0” (hereafter referred to as Open eBook) published 09/16/1999 in view of Kucera et al. (hereafter referred to as Kucera), US 4,864,502.

Regarding independent claim 10 and dependent claim 11, Open eBook teaches identifying a tag between a left and right term within a document in sections 2.2 and 3.1.5. Open eBook also teaches inserting additional metadata into a tag, in section 2.2 lines 7-12. It would have been obvious to one of ordinary skill in the art at the time the invention was made for one of ordinary skill in the art to have used the metadata ability of Open eBook to have placed a word break flag to separate two distinct words in the text.

Open eBook does not explicitly teach tagging a single word. Kucera does teach tagging a single word in col. 2 lines 54-64. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined Kucera into Open eBook to create the claimed invention. It would have been obvious and desirable to tag single words so that the metadata could be as descriptive as possible of the document.

9. Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over “Open eBook Publication Structure 1.0” (hereafter referred to as Open eBook) published

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09/16/1999 in view of Edelman et al. (hereafter referred to as Edelman), US 6,442,576 B1 filed 08/06/1997.

Regarding independent claim 14 and dependent claim 15, Open eBook teaches searching a manifest file for a file referenced by a Uniform Resource Locator (URL) in section 2.3. Open eBook does not teach identifying a URL within a document or if the file is identified with a reference string, replacing the URL with the reference string. Edelman does teach identifying a URL within a document and if the file is identified with a reference string, replacing the URL with the reference string in col. 2 lines 33-50.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined Edelman into Open eBook to create the claimed invention. It would have been obvious and desirable use the URL identification taught by Edelman and improve Open eBook so that the manifest file can be readily accessed through use of the identified URL. This would have increased the efficiency of the program processing the document.

10. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Murashita, US 6,330,574 filed 03/30/1998 in view of “Open eBook Publication Structure 1.0” (hereafter referred to as Open eBook) published 09/16/1999 as applied to claim 1 above, and further in view of Edelman et al. (hereafter referred to as Edelman), US 6,442,576 B1 filed 08/06/1997.

Regarding dependent claim 8, Murashita in view of Open eBook does not teach replacing a URL within the content information with a reference string. Edelman does teach replacing a URL within the content information with a reference string in col. 2 lines 33-50. It

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would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined Edelman into Murashita in view of Open eBook to create the claimed invention. It would have been obvious and desirable to utilize the URL replacement taught by Edelman in Murashita in view of Open eBook so that the document can be further compressed leading to less usage of storage space and shorter file transmission times.

Response to Arguments

11. Applicant's arguments, see page 12 lines 4-14, filed 01/02/2004, with respect to claims 24-31 have been fully considered and are persuasive. The rejection under 35 U.S.C. 102(a) as being anticipated by "Open eBook Publication Structure 1.0" published 09/16/1999 of claims 24-31 has been withdrawn.

12. Applicant's arguments filed 01/02/2004 have been fully considered but they are not persuasive. Regarding Applicant's argument on page 11 that Murashita fails to disclose inserting at least one code character into an electronic document to separate markup language from content, the Examiner believes Murashita teaches inserting code characters into a document and discriminating between tags and content and it would have been an obvious modification to one of ordinary skill in the art at the time of the invention to have inserted at least one code character into an electronic document to separate markup language from content.

Regarding Applicant's argument on page 11 that Murashita fails to disclose locating an attribute type within the tag, the Examiner believes Murashita does teach locating an attribute

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type within a tag in col. 3 lines 17-19. Murashita needs to know the attribute type of the tag so that the appropriate code may be inserted into the document.

Regarding Applicant's argument on pages 13 and 14 that Open eBook does not teach inserting at least one flag within the tag to form an encode tag structure, the Examiner believes the ability of Open eBook to use x-metadata, described in section 2.2 would have allowed one of ordinary skill in the art to have used the metadata to improve the computational ability of the document improving such electronic book features such as browsing and searching capabilities.

Regarding Applicant's argument on pages 14 and 15 that Murashita in view of Open eBook does not teach forming a converted document, the Examiner believes Murashita teaches forming a converted document in the abstract and fig. 6.

Regarding Applicant's argument on page 15 and 16 that Open eBook does not teach if the left and right terms are not part of a single word, inserting a word break flag between the left and right term, the Examiner believes it would have been obvious to one of ordinary skill in the art to have utilized the metadata ability taught in section 2.2 of Open eBook to have put an obviously put a word break flag between the two distinct words.

Regarding Applicant's argument on page 16 that the combination of Open eBook and Edelman does not disclose, teach, or suggest replacing part of the URL with the reference string and a flag for the file, the Examiner believes Edelman teaches replacing a found element with a substitute element in col. 2 lines 33-50 and that it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the substitute element with a flag to have indicated the search and substitution had already occurred for that element.

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Conclusion

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter J Smith whose telephone number is 703-305-5931. The examiner can normally be reached on Mondays-Fridays 7:00am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H Feild can be reached on 703-305-9792. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PJS
March 8, 2004


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SUPERVISORY PATENT EXAMINER